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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,381	03/30/2004	Jean-Marie Badoz	MICROM7	4714

7590 01/04/2007
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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/813,381

Applicant(s)

BADOZ, JEAN-MARIE

Examiner

Marc Jimenez

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8, 14, 15, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-11 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 12, 13, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/049,349.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6-28-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I in the reply filed on 10-17-06 is acknowledged.
2. Claims 7, 8, 14, 15, 21 and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claim 2** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 recites that the third machining operation is initially performed at the second depth and thereafter performed at a depth which becomes identical to the first depth. As written it is unclear how to make the invention because it is unclear how the second depth becomes identical to the first depth when the second depth is already greater than the first depth as recited in claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 4, 9, 11, 16 and 18**, are rejected under 35 U.S.C. 103(a) as being unpatentable over McSpadden (US5938440) in view of Admitted Prior Art found in figure 1 of the instant application (hereinafter APA).

McSpadden teaches a canal instrument having a working cross-section comprising three flutes (figure 14B) forming three cutting lips, wherein the three cutting lips are located on the working cross-section at positions corresponding to vertices of an isosceles triangle, grinding (col. 9, lines 64-65) first and second flutes **302,300** in a generally cylindrical blank during first and second machining operations (the forming of the first and second flutes is considered first and second machining operations) performed at locations on the blank which are separated by an angle of 120 degrees (the specific location is not claimed, therefore, the blank could be considered to be divided into 120 degree segments), and thereafter grinding a third flute **298** in the cylindrical blank by performing a third machining operation (the third machining operation is when the third flute is formed), wherein the first and second machining operations **300,302** are

Art Unit: 3726

performed at a first depth, and wherein the third machining operation **298** is performed at a second depth greater than the first depth.

McSpadden teaches the invention cited above with the exception of the three flutes having an “S” shape.

APA teaches in figure 1 S shape flutes.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of McSpadden with S shaped flutes, in light of the teachings of APA, in order to make use of known shapes for flutes to better ream a root canal.

Regarding claims 4, 11 and 18, the limitation “inclining” the grinding wheel relative to the longitudinal axis is broad enough to encompass moving the grinding wheel away or towards the blank.

Regarding claims 9 and 16, the first and second machining operations to form the first and second flutes **302,300** could be considered to be an “identical” and successive machining operation since they are both formed by grinding, hence an identical machining step. The limitation “complements” is broad enough to encompass merely machining the third flute **298**. It would be inherent when creating isosceles triangle cross there are sections of machining locations that would be greater than 120 degrees and less than 120 degrees because of the shape of an isosceles triangle (it is noted that both applicant in figures 2-4 of the instant application and figure 14B of McSpadden both form flutes with respect to an isosceles triangle shape).

Art Unit: 3726

7. **Claims 3, 10 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over McSpadden in view of APA as applied to claim 1 above, and further in view of Farzin-Nia (WO 99/37235).

McSpadden/APA teach the invention cited above with the exception of rotating the blank during grinding.

Farzin-Nia teaches rotating a blank during grinding (page 10, lines 9-12).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of McSpadden/APA with rotating the blank during grinding, in light of the teachings of Farzin-Nia, in order to symmetrically shape the canal instrument during grinding.

8. **Claims 9 and 16** rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art found in figure 1 of the instant application (hereinafter APA) in view of Matsutani (US4604884).

APA teaches in figure 1: a canal instrument having a working cross-section comprising three flutes forming lips having an S shape **20,21,22**, grinding first and second flutes in a generally cylindrical blank during first and second machining operations (ie. the operations needed to machine **20** and **21**), wherein the first and second machining operations are identical and successive machining operations performed at locations on the blank (for example they are identical in that they are both machined by an identical type grinding process, see also page 4, paragraph [0016] of applicant's specification), and thereafter grinding a third flute **22** in the cylindrical blank by performing a third machining operation which "complements" (the

limitation “complements” is broad enough to encompass merely machining the third flute **22**) the first and second machining operations to located the three cutting lips on the working cross-section.

APA teaches the invention cited above with the exception of the working cross-section being at positions corresponding to vertices of an isosceles triangle and performing machining at locations separated by an angle greater than 120 degrees.

Matsutani teaches that the cross section of the instrument could be an isosceles triangle (col. 7, lines 35-42). In addition, it would be inherent when creating isosceles triangle cross there are sections of machining locations that would be greater than 120 degrees and less than 120 degrees because of the shape of an isosceles triangle.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of APA with the cross section being an isosceles triangle and machining locations greater than 120 degrees, in light of the teachings of Matsutani, in order to make use of known shapes for flutes to better ream a root canal.

9. **Claims 10, 11, 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Matsutani as applied to claim 9 above, and further in view of Farzin-Nia (WO 99/37235).

APA/Matsutani teach the invention cited above with the exception of rotating the blank during grinding.

Farzin-Nia teaches rotating a blank during grinding (page 10, lines 9-12).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of APA/Matsutani with rotating the blank during grinding, in light of the teachings of Farzin-Nia, in order to symmetrically shape the canal instrument during grinding.

Regarding claims 11 and 18, the limitation “inclining” the grinding wheel relative to the longitudinal axis is broad enough to encompass moving the grinding wheel away or towards the blank.

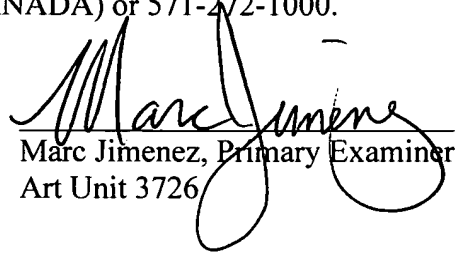
Allowable Subject Matter

10. Claims 5, 6, 12, 13, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Marc Jimenez, Primary Examiner
Art Unit 3726

MJ
12-14-06